Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte LEUNG K. HEUNG and GEORGE G. WICKS

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Appeal No. 1998-0346
Application No. 08/718,653

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ON BRIEF

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Before GARRIS, WARREN, and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 20-22, 24 and 26-37 which are all of the claims remaining in the application.

The subject matter on appeal relates to a process for making a composition for use in storing hydrogen. Specifically, this subject matter concerns a sol-gel method for preparing a metal

hydride composite wherein first and second mixtures of particular ingredients are combined to form a sol and metal hydride particles capable of absorbing and desorbing hydrogen made of a La-Ni-Al alloy are mixed with the sol, whereupon the resulting mixture is gelled and then dried to form an aerogel having the particles uniformly dispersed therein. This appealed subject matter is adequately illustrated by independent claim 32 which reads as follows:

32. A sol-gel method for preparing a metal hydride composite, said method comprising the steps of:

mixing a first alcohol and water to form a first mixture;

adjusting the pH of said first mixture;

mixing a second alcohol and an organometal to form a second mixture;

mixing said first and second mixtures to form a sol;

mixing particles of a metal hydride with said sol to form a third mixture, said particles being capable of absorbing and desorbing hydrogen, said metal hydride particles being made of a La-Ni-Al alloy;

gelling said third mixture to form a gel; and

drying said gel to form an aerogel having said particles uniformly dispersed therein.

The references set forth below are relied upon by the examiner in the obviousness-type double patenting rejection and the section 103 rejection before us on this appeal:

Ramamurthi et al. (Ramamurthi)	5,306,555	Apr. 26, 1994 (filed Jun. 26, 1992)
Heung et al. (Heung)	5,411,928	May 2, 1995 (filed May 24, 1993)

Claims 20, 24, 26, 27, 30, 32-34, 36 and 37 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Heung.

Additionally, claims "20-22, 24 and 36-37 [sic, 26-37] are rejected under 35 U.S.C. § 103 as being unpatentable over Ramamurthi" (answer, page 3).

As indicated on page 6 of the brief, the appellants have grouped the appealed claims together in accordance with the manner in which these claims have been grouped in the rejections above.

OPINION

For the reasons which follow, we will sustain the examiner's obviousness-type double patenting rejection but not her section 103 rejection.

On this appeal, the appellants have not contested the merits of the double patenting rejection on a technical or factual basis. Instead, it is the appellants' basic position that an obviousness-type double patenting rejection is unnecessary and inappropriate under the circumstances of this case.

Specifically, the appellants point out that the Heung patent will expire prior to the expiration date of any patent which may issue from the subject application. According to the appellants, therefore, the monopoly of the Heung patent would not be extended by issuing a patent on their application. Further in this regard, the appellants emphasize that a terminal disclaimer, which the examiner would accept as obviating her obviousness-type double patenting rejection, would not affect the expiration date of a patent issuing from this application since this date is prior to the Heung patent expiration date as earlier mentioned.

The appellants' position is implicitly built upon the proposition that the only basis for an obviousness-type double patenting rejection and a corresponding terminal disclaimer requirement constitutes extension of monopoly. This is incorrect. An additional basis constitutes the potential of harassment by multiple assignees. In re Van Ornum, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). Also see Manual of Patent Examining Procedure (MPEP) section 804.02 IV (July 1998). This is why an acceptable terminal disclaimer must include a common ownership provision pursuant to 37 CFR § 1.321(c)(3). In

re Van Ornum, 686 F.2d at 948, 214 USPQ at 770. It follows that the appellants' above noted argument must be regarded as unpersuasive.[1]

In light of the foregoing, we will sustain the examiner's obviousness-type double patent rejection of appealed claims 20, 24, 26, 27, 30, 32-34, 36 and 37 based upon the claims of the Heung patent.

The examiner's section 103 rejection, however, cannot be sustained. This is because the Ramamurthi patent simply contains no teaching or suggestion of the here claimed feature concerning metal hydride particles capable of absorbing and desorbing hydrogen and being made of a La-Ni-Al alloy. Apparently, the examiner concludes that it would have been obvious for an artisan with ordinary skill to provide the method of Ramamurthi with such a feature. On the record before us, the examiner plainly has

[1] The examiner views this argument of the appellants as unpersuasive because the Heung patent might expire, due to nonpayment of a maintenance fee, prior to expiration of a patent issuing from the subject application. We will not adopt this viewpoint because it appears to be inconsistent with the policy of the Patent and Trademark Office; see, for example, the language of the terminal disclaimer form on page 1400-63 at MPEP section 1490(Rev. 1, Feb. 2000).

failed to carry her initial burden of establishing a prima facie case in support of this evidentiary-unsupported obviousness conclusion.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Bradley R. Garris Administrative Patent Judge	)
Charles F. Warren Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
Thomas A. Waltz Administrative Patent Judge	)

BRG:tdl

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